

REMARKS

I. Claim Objections

Claims 12-14 and claims 21-35 were objected to due to certain typographical errors. These errors have been corrected to overcome the objections. In addition, claims 22-46 have been renumbered to claims 22-47 to correct the inadvertent numbering error of claim 22.

II. The 35 U.S.C. §101 Rejections

Claims 36-40 and claim 41 were rejected under 35 U.S.C. §101. Independent claims 36 and 41 have been amended to recite a computer readable medium having computer-executable code as suggested by the Examiner. Applicant respectfully submits that claims 36-40 and claim 41 have overcome the 101 rejections.

III. The 35 U.S.C. §103 Rejections

Claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,758,328 to Giovannoli (“GIOVANNOLI”) in view of Fan, “Focus on the Future: Harnessing the Internet to Streamline Procurement of Mechanical Equipment” (“FAN”). Applicant respectfully traverses the rejection.

A. Claim 1

It is axiomatic that the combination of the cited references in a §103 rejection must disclose every element in the rejected claim. Claim 1 recites a method for providing highly automated procurement services, comprising:

- (a) accessing a database initialized with information regarding a plurality of trading partners:
 - (1) said plurality of trading partners including customer and non-customer trading partners;

- (2) said information including trading relationship information involving at least a customer trading partner and another of said trading partners;
- (b) receiving a purchase request of a first trading partner among said trading partners;
- (c) automatically selecting at least one qualified trading partner from said trading partners based on said purchase request;
- (d) generating a purchase order based on:
 - (1) a portion of said trading relationship information pertaining to said at least one qualified trading partner;
 - (2) said purchase request; and
 - (3) without requiring direct communication between said first trading partner and said at least one qualified trading partner;
- (e) forwarding said purchase order to said at least one qualified trading partner;
- (f) receiving a notification pertaining to said at least one qualified trading partner; and
- (g) automatically processing said notification, including forwarding said notification to said first trading partner.

Based on the arguments presented below, Applicant respectfully submits that the combination of GIOVANNOLI and FAN fails to disclose or suggest at least one element of claim 1.

1. GIOVANNOLI Fails to Disclose or Suggest the Purchase Order as Recited in Claim 1

In this Office Action, the Examiner agreed that “GIOVANNOLI does not expressly disclose generating a purchase order.” Instead, the Examiner relied on his personal knowledge and FAN for disclosing the step of generating a purchase order as recited in claim 1.

First, the Examiner relied on the conclusory statement that “purchase orders are well known.” Improper hindsight reasoning should not be applied in support of

an obviousness rejection. MPEP 2145.X.A. Hindsight reasoning is proper if it only takes into account knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made, but not knowledge gleaned from applicant's disclosure. Id.

Even if purchase orders are well known in the art, the Examiner has failed to demonstrate that the purchase order being generated as recited in claim 1 was well known. Applicant respectfully submits that the Examiner applied improper hindsight reconstruction based on the Applicant's Specification and/or the Examiner's personal knowledge in support of the obviousness rejection. If the Examiner believes otherwise, the Examiner is requested to provide an Affidavit so stating in accordance with 37 CFR 1.104(d)(2) and MPEP 2144.03.

2. FAN Fails to Disclose or Suggest the Purchase Order as Recited in Claim 1

Second, the Examiner relied on FAN for allegedly disclosing the step of generating a purchase order as recited in claim 1. In FAN, a purchase order is only generated after the buyer and supplier have conducted direct negotiations with each other and have reached an agreement. In other words, a purchase order is not generated if the buyer and supplier do not reach an agreement after direct negotiation. A purchase order is also not generated if the buyer and supplier do not directly negotiate with each other (e.g., if they do not wish to directly negotiate). Thus, in FAN, direct communication and agreement are both required before a purchase order is generated.

If they wish, buyers and suppliers can conduct online negotiations over price, delivery, or other terms and conditions. When they have reached an agreement, a purchase order is automatically generated online and sent to both parties electronically. FAN, paragraph 14.

In contrast, claim 1 recites the step of generating a purchase order ... without requiring direct communication between said first trading partner and said at least one qualified trading partner. The absence of direct communication between trading partners was inherently present in the original claim 1. Thus, claim 1 has been amended merely to make such inherent limitation explicit.

The Examiner has failed to point out where in the cited references (i.e., GIOVANNOLI and FAN) the suggestion or teaching of the claimed invention (i.e., generating a purchase order without requiring direct communication between the trading partners) may be found. Thus, based on all the foregoing, Applicant respectfully submits that claim 1 is in condition for allowance.

C. Dependent Claims 2-19

Dependent claims 2-19 are dependent on claim 1. Based on the foregoing arguments regarding claim 1, these dependent claims should also be in condition for allowance.

D. Claim 20

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over GIOVANNOLI in view of FAN. Applicant respectfully traverses the rejection.

Claim 20 includes similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, claim 20 is also not unpatentable over GIOVANNOLI and FAN and should be in condition for allowance.

E. Claims 21-35

Claims 21-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over GIOVANNOLI in view of FAN. Applicant respectfully traverses the rejection.

Independent claim 21 includes similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, claim 21 is also not unpatentable over GIOVANNOLI and FAN and should be in condition for allowance.

Claims 22-35 are dependent on claim 21. Based on the foregoing regarding claim 21, these dependent claims should also be in condition for allowance.

F. Claims 36-40

Claims 36-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over GIOVANNOLI in view of FAN. Applicant respectfully traverses the rejection.

Independent claim 36 includes similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, claim 36 is also not unpatentable over GIOVANNOLI and FAN and should be in condition for allowance.

Claims 37-40 are dependent on claim 36. Based on the foregoing regarding claim 36, these dependent claims should also be in condition for allowance.

G. Claim 41

Claim 41 was rejected under 35 U.S.C. §103(a) as being unpatentable over GIOVANNOLI in view of FAN. Applicant respectfully traverses the rejection.

Claim 41 includes similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, claim 41 is also not unpatentable over GIOVANNOLI and FAN and should be in condition for allowance.

H. Claims 42-46

Claims 42-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over GIOVANNOLI in view FAN. Applicant respectfully traverses the rejection.

Independent claim 42 includes similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, claim 42 is also not unpatentable over GIOVANNOLI and FAN and should be in condition for allowance.

Claims 43-46 are dependent on claim 42. Based on the foregoing regarding claim 42, these dependent claims should also be in condition for allowance.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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